

IAP13 Rec'd PCT/PTO 23 OCT 2006

Express Mail No. EV 686 024 569 US

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application of:	Schadt et al.	Confirmation No.:	9607
Serial No.:	10/540,405 national stage filing of PCT/US03/41613	Art Unit:	To be assigned
Filed:	December 24, 2003	Examiner:	To be assigned
For:	COMPUTER SYSTEMS AND METHODS FOR ASSOCIATING GENES WITH TRAITS USING CROSS SPECIES DATA	Attorney Docket No:	9301-210-999

**REQUEST FOR RECONSIDERATION**

Mail Stop PCT  
Commissioner for Patents  
Office of PCT Legal Administration  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Attention: Office of the PCT Legal Administration:

Sir:

Applicants respectfully request reconsideration of the August 22, 2006 Decision on Applicants' Request to add John Lamb as an Inventor (hereinafter "Request") in the above-captioned application pursuant to 37 C.F.R. § 1.497(d) filed June 30, 2006. In the Decision, Applicants' Request was dismissed without prejudice because the Consent of Assignee enclosed with the Request was signed by a person whose titled is not presumed to have authority to sign on behalf of the assignee.

With this Request for Reconsideration, Applicants submit (i) a copy of the August 22, 2006 Decision and (ii) a revised Consent of Assignee to Change of Inventorship Under 37 C.F.R. § 1.497(d)(3) and Statement Under 37 C.F.R. § 3.73(b) signed by Edward M. Yoshida, Managing Counsel of assignee Rosetta Inpharmatics LLC (hereinafter, "Revised Consent"). The Revised Consent states that Edward M. Yoshida is authorized to act on behalf of the Assignee.

The period for response is two months from the August 22, 2006 mail date of the Decision. Accordingly, since this Request for Reconsideration is being filed on October 23, 2006 (October 22, 2006 falling on a Sunday), no fee is believed due. However, should any fees be required, please charge any required fees to Jones Day Deposit Account No. 50-3013. A copy of this sheet is enclosed.

Date: October 23, 2006

Respectfully submitted,

*Brett Jay Jay* Reg. No. 42,813

*for*

Adriane M. Antler

32,605  
(Reg. No.)

**JONES DAY**

222 East 41st Street

New York, New York 10017

Phone: (212) 326-3939

Enclosures

Express Mail No.: DRAFT---

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Schadt et al.

Confirmation No.: 9607

Serial No.: 10/540,405 national stage filing  
of PCT/US03/41613 Art Unit: To be assigned

Filed: December 24, 2003 Examiner: To be assigned

For: COMPUTER SYSTEMS AND  
METHODS FOR  
ASSOCIATING GENES WITH  
TRAITS USING CROSS  
SPECIES DATA  
Attorney Docket No: 9301-210-999**CONSENT OF ASSIGNEE TO CHANGE OF INVENTORSHIP UNDER  
37 C.F.R. § 1.497 (d)(3) AND STATEMENT UNDER 37 C.F.R. § 3.73(b)**Mail Stop PCT  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

Rosetta Inpharmatics LLC, as the assignee of the entire right, title and interest in the above identified patent application, hereby consents to correction of the inventorship of this application. Specifically, the assignee consents to the addition of John Lamb, a citizen of the United States whose residence is 1216 N. 172<sup>nd</sup> Street, Shoreline, Washington 98133, as co-inventor of the instant application. Thus, the true inventors of the claimed subject matter of the above-identified International Application No. PCT/US03/41613 are Eric E. Schadt, Stephanie A. Monks, and John Lamb.

Rosetta Inpharmatics LLC states that it is the assignee of the entire right, title and interest in the patent application identified above by virtue of an assignment from the inventors of the patent application identified above. A copy of the assignment is enclosed as Exhibit A.

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

ROSETTA INPHARMATICS LLC

Date: 18 October 2006

By:

  
 Edward M. Yoshida  
 Managing Counsel

**EXHIBIT A**

Copy of Assignment of PCT/US03/41613 from Inventors to Rosetta Inpharmatics LLC

**COPY**

JOINT

ASSIGNMENT

WHEREAS, WE, ERIC E. SCHADT, STEPHANIE A. MONKS, and JOHN LAMB, ASSIGNORS, respectively citizens of the United States, the United States, and the United Kingdom, respectively residing at 810 5th Street, Kirkland, Washington 98033, 3414 N. Ramsey Street, Stillwater, Oklahoma 74075, and 1216 N. 172<sup>nd</sup> Street, Shoreline, Washington, are the inventors of the invention in COMPUTER SYSTEMS AND METHODS FOR ASSOCIATING GENES WITH TRAITS USING CROSS SPECIES DATA for which we have executed an application for a Patent of the United States

- which is identified by Jones Day docket no. 9301-210-999
- which was filed on December 24, 2003, Application No. 10/540,405, U.S. national stage of International Application No. PCT/US03/041613

and WHEREAS, ROSETTA INPHARMATICS LLC, a limited liability company organized and existing under the laws of the state of Delaware, and having an office for the transaction of business at 401 Terry Avenue North, Seattle, Washington 98108, ASSIGNEE, is desirous of obtaining our entire right, title and interest in, to and under the said invention and the said application:

NOW, THEREFORE, in consideration of the sum of One Dollar (\$1.00) to us in hand paid, and other good and valuable consideration, the receipt of which is hereby acknowledged, we, the said ASSIGNORS, have sold, assigned, transferred and set over, and by these presents do hereby sell, assign, transfer and set over, unto the said ASSIGNEE, its successors, legal representatives and assigns, our entire right, title and interest in, to and under the said invention, and the said United States application and all divisions, renewals and continuations thereof, and all Patents of the United States which may be granted thereon and all reissues and extensions thereof; and all applications for industrial property protection, including, without limitation, all applications for patents, utility models, and designs which may hereafter be filed for said invention in any country or countries foreign to the United States, together with the right to file such applications and the right to claim for the same the priority rights derived from said United States application under the Patent Laws of the United States, the International Convention for the Protection of Industrial Property, or any other international agreement or the domestic laws of the country in which any such application is filed, as may be applicable; and all forms of industrial property protection, including, without limitation, patents, utility models, inventors' certificates and designs which may be granted for said invention in any country or countries foreign to the United States and all extensions, renewals and reissues thereof;

AND WE HEREBY authorize and request the Commissioner for Patents and any Official of any country or countries foreign to the United States, whose duty it is to issue patents or other evidence or forms of industrial property protection on applications as aforesaid, to issue the same to the said ASSIGNEE, its successors, legal representatives and assigns, in accordance with the terms of this instrument.

AND WE HEREBY covenant and agree that we have full right to convey the entire interest herein assigned, and that we have not executed, and will not execute, any agreement in conflict herewith.

AND WE HEREBY further covenant and agree that we will communicate to the said ASSIGNEE, its successors, legal representatives and assigns, any facts known to us respecting said invention, and testify in any legal proceeding, sign all lawful papers, execute all divisional, continuing, reissue and foreign applications, make all rightful oaths, and generally do everything possible to aid the said ASSIGNEE, its successors, legal representatives and assigns, to obtain and enforce proper protection for said invention in all countries.

IN TESTIMONY WHEREOF, We hereunto set our hands and seals the day and year set opposite our respective signatures.

Date June 27, 2006 L.S.  
Eric E. Schadt

Date June 27, 2006 L.S.  
Stephanie A. Monks

Date June 26th, 2006 L.S.  
John Lamb

State of Washington )  
County of King ) SS.:  
)

On June 27, 2006, before me, Cheryl J. Brass, Notary Public, personally appeared Eric E. Schadt, personally known to me on the basis of satisfactory evidence to be the person(s) whose name(s) is subscribed to the within instrument and acknowledged to me that he/she/they executed the same in his/her/their authorized capacity(ies), and that by his/her/their signature(s) on the instrument the person(s), or the entity upon behalf of which the person(s) acted, executed the instrument.

WITNESS my hand and official seal

Cheryl J. Brass  
(my appointment expires Sept 28, 2007)

Notary Public  
State of Washington  
CHERYL J. BRASS  
MY COMMISSION EXPIRES  
Sept. 28, 2007

State of \_\_\_\_\_ )  
County of \_\_\_\_\_ ) SS.:  
)

On June 26, 2006, before me, Stephanie A. Monks, Notary Public, personally appeared Stephanie A. Monks, personally known to me on the basis of satisfactory evidence to be the person(s) whose name(s) is subscribed to the within instrument and acknowledged to me that he/she/they executed the same in his/her/their authorized capacity(ies), and that by his/her/their signature(s) on the instrument the person(s), or the entity upon behalf of which the person(s) acted, executed the instrument.

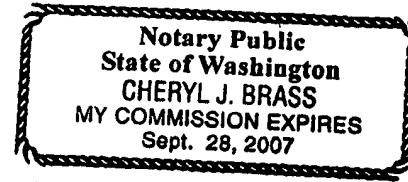
WITNESS my hand and official seal

State of Washington )  
County of King ) SS.:  
)

On June 26, 2006, before me, Cheryl J. Brass, Notary Public, personally appeared John Lamb, personally known to me on the basis of satisfactory evidence to be the person(s) whose name(s) is subscribed to the within instrument and acknowledged to me that he/she/they executed the same in his/her/their authorized capacity(ies), and that by his/her/their signature(s) on the instrument the person(s), or the entity upon behalf of which the person(s) acted, executed the instrument.

WITNESS my hand and official seal

Cheryl J. Brass  
(My appointment expire Sept 28, 2007)



FROM : OSU DEPT OF STATISTICS

PHONE NO. : 4057443533

28 2006 10:22AM P4  
T-106 P.004/005 P-376

JOINT

## ASSIGNMENT

WHEREAS, WE, ERIC E. SCHADT, STEPHANIE A. MONKS, and JOHN LAMB, ASSIGNORS, respectively citizens of the United States, the United States, and the United Kingdom, respectively residing at 810 5th Street, Kirkland, Washington 98033, 3414 N. Ramsey Street, Seattle, Washington 98103, and 1216 N. 172<sup>nd</sup> Street, Shoreline, Washington, are the inventors of the invention in COMPUTER SYSTEMS AND METHODS FOR ASSOCIATING GENES WITH TRAITS USING CROSS SPECIES DATA for which we have executed an application for a Patent of the United States

which is identified by Jones Day docket no. 9301-210-999  
 which was filed on December 24, 2003, Application No. 10/540,403, U.S. national stage of International Application No. PCT/US03/041613

and WHEREAS, ROSETTA INPHARMATICS LLC, a limited liability company organized and existing under the laws of the state of Delaware, and having an office for the transaction of business at 401 Terry Avenue North, Seattle, Washington 98108, ASSIGNEE, is desirous of obtaining our entire right, title and interest in, to and under the said invention and the said application:

NOW, THEREFORE, in consideration of the sum of One Dollar (\$1.00) to us in hand paid, and other good and valuable consideration, the receipt of which is hereby acknowledged, we, the said ASSIGNORS, have sold, assigned, transferred and set over, and by these presents do hereby sell, assign, transfer and set over, unto the said ASSIGNEE, its successors, legal representatives and assigns, our entire right, title and interest in, to and under the said invention, and the said United States application and all divisions, renewals and continuations thereof, and all Patents of the United States which may be granted thereon and all issues and extensions thereof; and all applications for Industrial property protection, including, without limitation, all applications for patents, utility models, and designs which may hereafter be filed for said invention in any country or countries foreign to the United States, together with the right to file such applications and the right to claim for the same the priority rights derived from said United States application under the Patent Laws of the United States, the International Convention for the Protection of Industrial Property, or any other international agreement or the domestic laws of the country in which any such application is filed, as may be applicable; and all forms of industrial property protection, including, without limitation, patents, utility models, inventors' certificates and designs which may be granted for said invention in any country or countries foreign to the United States and all extensions, renewals and releases thereof;

AND WE HEREBY authorize and request the Commissioner for Patents and any Official of any country or countries foreign to the United States, whose duty it is to issue patents or other evidence or forms of industrial property protection on applications as aforesaid, to issue the same to the said ASSIGNEE, its successors, legal representatives and assigns, in accordance with the terms of this instrument.

AND WE HEREBY covenant and agree that we have full right to convey the entire interest herein assigned, and that we have not executed, and will not execute, any agreement in conflict herewith.

AND WE HEREBY further covenant and agree that we will communicate to the said ASSIGNEE, its successors, legal representatives and assigns, any facts known to us respecting said invention, and testify in any legal proceeding, sign all lawful papers, execute all divisional, continuing, reissue and foreign applications, make all rightful oaths, and generally do everything possible to aid the said ASSIGNEE, its successors, legal representatives and assigns, to obtain and enforce proper protection for said invention in all countries.

IN TESTIMONY WHEREOF, We hereunto set our hands and seals the day and year set opposite our respective signatures.

Date June 28, 2006 L.S.

Eric E. Schadt

Date June 28, 2006 L.S.

Stephanie A. Monks

Date June 28, 2006 L.S.

John Lamb

State of \_\_\_\_\_  
 County of \_\_\_\_\_ } SS:

On June 28, 2006, before me, Notary Public, personally appeared Eric E. Schadt, personally known to me on the basis of satisfactory evidence to be the person(s) whose name(s) is subscribed to the within instrument and acknowledged to me that he/she/they executed the same in his/her/their authorized capacity(ies), and that by his/her/their signature(s) on the instrument the person(s), or the entity upon behalf of which the person(s) acted, executed the instrument.

WITNESS my hand and official seal

FROM : OSU DEPT OF STATISTICS

PHONE NO. : 4057443533

JUN 28 2006 10:23AM P5  
P-278 P-006/008State of Oklahoma } SS.:  
County of Payne )

On June 28, 2006, before me, Stephanie A. Murphy, Notary Public, personally appeared Stephanie A. Murphy, personally known to me on the basis of satisfactory evidence to be the person(s) whose name(s) is subscribed to the within instrument and acknowledged to me that he/she/they executed the same in his/her/their authorized capacity(ies), and that by his/her/their signature(s) on the instrument the person(s), or the entity upon behalf of which the person(s) acted, executed the instrument.

WITNESS my hand and official seal

Stephanie A. Murphy

my Commission expires July 18, 2008

State of } SS.:  
County of )

On June 28, 2006, before me, John Lamb, Notary Public, personally appeared John Lamb, personally known to me on the basis of satisfactory evidence to be the person(s) whose name(s) is subscribed to the within instrument and acknowledged to me that he/she/they executed the same in his/her/their authorized capacity(ies), and that by his/her/their signature(s) on the instrument the person(s), or the entity upon behalf of which the person(s) acted, executed the instrument.

WITNESS my hand and official seal

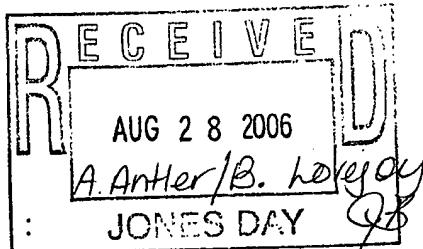


UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

20583  
JONES DAY  
222 East 41<sup>st</sup> Street  
New York, NY 10017

22 AUG 2006



In re Application of  
SCHADT et al  
U.S. Application No.: 10/540,405 ✓  
PCT No.: PCT/US2003/041613  
Int. Filing Date: 24 December 2003  
Priority Date: 27 December 2002  
Attorney's Docket No.: 9301-210-999 ✓  
For: COMPUTER SYSTEMS AND  
METHODS FOR ASSOCIATING  
GENES WITH TRAITS USING CROSS  
SPECIES DATA

**DECISION**

Request for Reconsideration  
due 10-22-06.

This is a decision on the request to add an inventor in the above-captioned application pursuant to 37 CFR 1.497(d) filed 30 June 2006.

**BACKGROUND**

On 03 January 2006, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, an oath or declaration in compliance with 37 CFR 1.497(a) and (b) was required. Applicants were given two months to respond with extensions of time available.

On 30 June 2006, applicants filed the subject petition which was accompanied by, *inter alia*, a four-month extension and fee; an executed declaration; the processing fee; a copy of an assignment; a "Statement of John Lamb Under 37 CFR § 1.497(d)(1)"; a "Consent of Assignee Under 37 CFR § 1.497(d)(3) and Statement Under 37 CFR 3.73(b)."

**DISCUSSION**

Applicants request to add John Lamb as an inventor in the above-captioned application. 37 CFR 1.497(d) applies when the inventorship in a national stage application filed under 35 U.S.C. 371 differs from that set forth in the international application (see 37 CFR 1.48(f)(1)). 37 CFR 1.497(d) states, in part:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:

- (1) A statement from each person being added as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17(l); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees.

Here, applicants filed a statement by John Lamb who requests to be added as an inventor in the above-captioned application. Mr. Lamb states that the "error in inventorship in the PCT application occurred without deceptive intention on my part." The processing fee of \$130.00 has been paid.

Applicants also submitted a document titled "Consent of Assignee Under 37 CFR 1.497(d)" consenting to the change of inventorship in the above-identified application. This document was signed by Edward M. Yoshida, as Managing Counsel.

The Consent of Assignee is not accepted for the following reason.

MPEP § 324 states that: "[a] person having a title (manager, director, administrator; general counsel) that does not clearly set forth that person as an officer of the assignee is not presumed to be an officer of the assignee or to have authority to sign the statement on behalf of the assignee. Here, the consent of assignee was signed by Mr. Yoshida as Managing Counsel of Rosetta Inpharmatics LLC. This position is not presumed to have authority to sign the statement on behalf of the assignee. In addition, the submission does not set forth that Mr. Yoshida is authorized to act on behalf of the assignee.

Therefore, all the requirements of 37 CFR 1.497(d) are not yet complete.

### CONCLUSION

For the reason discussed above, applicants' request under 37 CFR 1.497(d) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter deposited with the United

States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

*James Thomson*

James Thomson  
Attorney Advisor  
Office of PCT Legal Administration

Tel.: (571) 272-3302